

USPTO Video Conference Center 2002 Lecture Descriptions

PATENTS

35 USC 101 & USC 112 § 1 - Examiners Guidelines for Utility and Enablement

This fundamental class is a must for every patent prosecutor. First, attendees get an overview of the utility guidelines and the procedures to be followed when analyzing patent applications for compliance with the utility requirements of 35 U.S.C. §101. The primary purpose of this lecture is to define the meaning of the statutory requirements of utility and to disseminate current examination practice in regard to the analysis for compliance with the utility requirement. By the end of this class, you will be better able to:

- Identify the basic requirements for statutory utility
- List the types of applications requiring utility
- Define the meaning and requirements of utility in an application
- Locate areas of disclosure, which may raise questions of utility
- Understand how examiners treat utility problems encountered in applications, and
- Prepare possible responses to rejections based upon lack of utility.

Affidavit Practice: 37 CFR 1.131 & 1.132

The information provided in this session is a great benefit to attorneys/applicants because it teaches the USPTO's way of doing things. The lecture is designed to teach examiners the analytical skills needed to evaluate whether an affidavit filed under 37 CFR 1.131 may be used as evidence to swear behind a reference and whether an affidavit filed under 37 CFR 1.132 may be used as evidence to overcome a ground of rejection or an objection. When attorneys/applicants know what is needed in each affidavit type, and when it is appropriate to employ an affidavit, prosecution can be more effective.

Board of Patent Appeals and Interferences

All you've ever wanted to know about the BPAI will be presented in this seminar: Who sits on the board, what training and experience are required, what is a panel, what does each member do, and caseload considerations start the session. How the BPAI judges are trimming appeals inventory and speeding up interferences will also be discussed.

The lecturer will explain the process and procedures required when making an Appeal to the Board including how to contact an oral conduct hearing, BPAI decisions and requests for rehearing. The BPAI also conducts and decides interferences, so the presenter will also cover the process used in an interference case.

Double Patenting

Learn how the Patent Academy teaches examiners to treat applications containing claims which conflict with claims in applicant's other applications or patents, or claims in other commonly assigned (or owned) applications. Topics include:

- Grounds for prohibiting double patenting
- Treatment of conflicting claims
- Terminal disclaimers
- Protection against Double Patenting rejections
- Conflict between design and utility claims, and
- Duplicate claims

Examiner Guide for Computer-Related Inventions: ** (Currently undergoing a course update.)**

These guidelines have been developed to assist PTO personnel in the examination of drawn to computer-related inventions (includes inventions implemented in a computer and inventions employing computer-readable media). The guidelines are based on the Office's current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit and the

Federal Circuit's predecessor courts. There will be an overview of these guidelines and then a demonstration of their application by use of a number of sample claims.

Final Rejection and After Final Practice

This lecture provides valuable information to attendees because it is designed to help trainee examiners understand the reasoning behind the PTO's "m.o." regarding Office actions, Attendees will learn:

- To recognize when an Office action may and may not be made final
- To understand why actions are made final
- To discover what recourse is available to an applicant in response to a final rejection, and
- To recognize when an amendment after final should and should not be entered.

Hot Topics in Biotechnology Plant Prosecution

Latest topics of interest including written description, expressed sequence tags (EST's), single nucleotide polymorphisms (SNP's), common pitfalls in CPA and Rule 129 (a) practice, sequence rules, and deposit requirements.

New and Pending Issues in the USPTO

This seminar will give an overview of recent and pending legislative issues affecting the US and international patent systems. Previous topics have included the following Harmonization Uruguay Round Table Agreements, NAFTA, US-Japan Accords, early publication, expanded reexamination, prior user rights and other issues.

Obviousness under 35 USC 103

Understand the meaning of 35 USC 103. Learn to apply the standards used to establish a legal conclusion of obviousness. Treat the various issues that inevitably arise when applying 35 USC 103. By the end of this session, you should be able to recognize and understand the following concepts related to obviousness:

- The statute;
- Prima facie obviousness;
- The Graham test;
- Scope and content of prior art;
- Evidence of prior art comprising references, admissions and affidavits;
- Analogous art; and differences between the prior art and the claims at issue.

Attendees will also gain a level of skill in the pertinent art comprising:

- Motivation;
- Hindsight;
- Motivation different from applicant's
- Art recognized equivalence for the same purpose;
- Physical incorporation;
- Destroying a reference;
- Changing principle of operation and number of references combined.
- Secondary considerations comprising unexpected result; long felt need; and commercial success will also be discussed.

Novelty 35 USC 102

Participants will learn to determine whether a reference qualifies as prior art under 35 USC 102 (a), (b), or (e) and determine whether a single reference teaches all the elements of a claimed invention.

PETITIONS

Every patent attorney needs to know how to handle **petitions** expeditiously, efficiently and with a minimum of error. You will learn the basic principles of petition practice and the two main avenues of ex parte review – appeal and petition. Identify the various types and components of petitions handled in the

Office of the Deputy Commissioner for Patent Examination Policy, as well as in the Examining Corp and the requirements that MUST be met to have a petition granted. Become more effective in your practice before the Office by getting guidance on how to 1) avoid the most common errors that lead to petitions in the first place, and 2) avoid errors in the petitions themselves.

Proposed New Rule Changes: **(Based upon current or pending legislative issues)

The presentation will cover current rulemaking being undertaken by the PTO. Included will be preparation of a final rule on "Patent Business Goals" for which a Notice of Proposed Rulemaking was published, 64 Fed. Reg. 53772 (October 4, 1999). This includes topics such as; changes in obtaining small entity status, reduced time for filing corrected or formal drawings, permitting the electronic submission of voluminous material, such as computer program listings, restrictions on preliminary amendment practice. Also included are issues relating to PTO implementation of the American Inventor's Protection Act of 1999 and of the Intellectual Property and Communications Omnibus Reform Act of 1999, such as Subtitle D – Patent Term Guarantee, Subtitle E – Domestic Publication of Patent Applications.

Re-Exam and Reissue

The lecture provides an overview of the statutes (35 USC 251 and 35 USC 302-305), rules (37 CFR 1.171 – 1.179 and 37 CFR 1.510-1.552) and MPEP requirements governing reissue applications and ex parte reexamination proceedings, respectively. The objectives include enabling the practitioner to distinguish reissue practice from other means of correcting errors in issued patents, in particular ex parte reexamination practice. The attendee will also learn:

- To recognize the appearance of a reissue application or a reexamination proceeding by an inspection of its form and contents;
- To understand how the USPTO applies to the examination process the key provisions of the statutes;
- To recognize the importance of and the emphasis on a reissue oath/declaration and to be able to distinguish such from the oath or declaration of a utility application;
- Understand the primary similarities and differences between reissue applications, ex parte reexamination proceedings, and regular utility applications and their respective examinations.

35 USC 112-2 paragraph, Rejections Not Based on Prior Art

This session will analyze the claims to determine whether or not one skilled in this art can determine the metes and bounds of a claim with a fair degree of certainty. Attendees will be taught to understand the criteria for determining clear and distinct claim language, and understand the criteria for determining clear and distinct claim language, and understand the policy reasons for 35 USC 112-2. The session also enables the practitioner to understand appropriateness of rejections in accordance with 35 USC 112.

US Classification and IPC

The basics of the US Classification System, the ideas behind classification, the structure of a class and the relationship between the subclasses in a particular class will be covered in the first hour. The second hour will cover the general structure of the IPC, features of the IPC, and aids to using the IPC. Also included will be how IPC is used in the USPTO and how some variants of the IPC are used in the USPTO.

Unity of Invention

The objective is to understand unity of invention practice as it applies to national stage applications filed under 35 USC 371 and to international applications filed under the Patent Cooperation Treaty. The participants will be able to determine how unity of invention practice applies and whether claims in a given application lack unity of invention.

State Street Case

The State Street decision overturned assumptions about the patentability of "mathematical algorithms" and "business methods" applications. Find out how the USPTO is addressing the State Street and AT&T decisions. The lecture addresses the legal and practical issues concerning electronic business and

software patents. Included in the presentation is material that is used to train examiners in their determination of whether claims are statutory under 35 USC 101.

Understanding Foreign Patent Documents

During this session, the attendee will be shown how to interpret various foreign records that have been retrieved through database searches such as Dialog, Orbit and Questel. Using sample printouts, the instructor will demonstrate how to read symbols and codes to find bibliographic information, including information on filing, publication, priority, and where to find related prior art. Using these demonstrated techniques you will be able to interpret relevant information on any foreign database retrieved document.

The Patent Cooperation Treaty

This is a two-part lecture on the Patent Cooperation Treaty. Representatives from the PCT Special Programs Office of the USPTO teach a basic seminar on practice and procedures of the Patent Cooperation Treaty from filing an international application to entering the national phase in the USPTO.

Patent Cooperation Treaty (PCT) Part I

The first session starts with an overview of the PCT process including the international phase and the national phase as well as the advantages of using PCT for filing foreign patent applications. Next the participants are given detailed information on how to file an international application. Participants taught how to properly fill out a PCT Request form including information on using PCT-EASY, the self-validating software for generating the Request.

Patent Cooperation Treaty (PCT) Part II

The second session continues with information on filing a Demand for International Preliminary Examination. Next participants learn about national stage entry in the US under 35 USC 371 and an alternative strategy for filing a US patent based upon the international application. The session ends with helpful hints on the PCT process including how to record changes in the applicant, how to delay or prevent publication of the international application, and a discussion of important forms that should be monitored during the international phase.

TRADEMARKS

E-TEAS

It has never been easier to file for a Trademark. The Trademark Electronic Application System (TEAS) allows you to fill out an application form and check it for completeness over the Internet. Using e-TEAS you can then submit the application directly to the USPTO over the Internet, paying by credit card or through an existing USPTO deposit account. Using PrinTEAS, you can print out the completed application for mailing to the USPTO, paying by check or money order through an existing USPTO deposit account. Both e-TEAS and PrinTEAS are available from the Internet and will be covered in the lecture.

Trademark Tips for Paralegals

This seminar will provide an explanation of the trademark process aimed at non-attorney legal professionals. Legal Staff of the Office of the Commissioner for Trademarks will provide an explanation of the trademark process, including an overview of the Office and updates on pendency for new applications. They will provide insight on why trademark applications go abandoned; tips to avoid abandonment; and what to do when your application is abandoned. They will briefly explain the difference between a petition and an appeal and a petition and a request for reinstatement. They will also provide a list of contacts at the PTO and other handouts, to help you get the right answer, right away.

Substantive Trademark Refusals

A discussion of the different substantive trademark refusals issued by the PTO and what you can do about them.

Trademark Classification Issues and Identification

A presentation discussing the common practical problems in using the Trademark Classification System.

Trademark Law Treaty Implementation Act

On October 30, 1999, the Trademark Law Treaty Implementation Act (TLTIA) became effective. This lecture will provide an overview of TLTIA, with specific emphasis on changes in pre-examination, examination and post registration processes.

Trademark Trial and Appeal Board Issues

Topics for discussion include: the pre-trial phase of opposition and cancellation proceedings including pleadings and discovery, the trial and decision phases of opposition and cancellation proceedings including the submission of trial evidence and how recently proposed rule changes would affect practice before the TTAB.